



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,968	10/01/2003	Katsuhisa Ogawa	B588-656 (25815.672)	9275

26272 7590 02/02/2010  
COWAN LIEBOWITZ & LATMAN P.C.  
JOHN J TORRENTE  
1133 AVE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
----------

CLOUD, JOIYA M

ART UNIT	PAPER NUMBER
----------	--------------

2444

MAIL DATE	DELIVERY MODE
-----------	---------------

02/02/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/677,968	<b>Applicant(s)</b> OGAWA, KATSUHISA	
	<b>Examiner</b> Joiya M. Cloud	<b>Art Unit</b> 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

This action is responsive to the communication filed 10/07/2009. Claims 16-20 are PENDING.

Applicant's arguments have been carefully considered, but are moot in view of new ground(s) of rejection, necessitated by Applicant's substantial amendments (i.e. "*an IPv6 address of a sending side included in the signal transmitted from the terminal apparatus...to coincide with lower-order 64 bits of the IPv6 address acquired from the transmitted signal...*" ) which have affected the scope thereof.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 16-20**, are rejected under **35 U.S.C. 103(a)** as being unpatentable over **Reuss (U.S. Patent No. 7,376,123 B2)** in view of **Saito (US Publication No. 00700667 A1)**.

**As per claim 16**, Reuss teaches a service provision method, comprising:  
acquiring before shipment of a terminal apparatus a host address of the terminal apparatus as connected to a first network (**a unique MAC address acquired before**

Art Unit: 2444

**shipment, in other words before asset tracking, col. 4, lines 47-61 and col. 7, lines 50-**

**54);** acquiring owner information of the terminal apparatus (**col. 6, lines 34-44);**

acquiring after shipment (when the asset is being utilized and desired for tracking) of the terminal apparatus, when a signal is transmitted from the terminal apparatus via the second network, a host address and a network address of a sending side included in the signal;

Reuss does not explicitly disclose acquiring a network address of the second network in accordance with the acquired owner information acquired at the second acquisition step from a database storing the network address of the second network and the owner information of the terminal apparatus and determining the host address of the terminal apparatus acquired before shipment of the terminal apparatus and the acquired network address of the second network to coincide with the host address and the network address acquired after shipment of the terminal apparatus and of providing a service, via the Internet, to the terminal apparatus via the second network

Saito discloses acquiring a network address of the second network in accordance with the acquired owner information acquired at the second acquisition step from a database storing the network address of the second network and the owner information of the terminal apparatus (**col. 14, lines 8-35, where the network address of the second network (responding terminal/destination terminal) is acquired the server in accordance with owner information in a database, see also col. 17, lines 36-57)** and determining the host address of the terminal apparatus to coincide with lower-order 64 bits of the IPv6 address acquired from the transmitted signal and the network address of

Art Unit: 2444

the second network acquired from the database in accordance with the acquired owner information to coincide with higher-order 64 bits of the IPv6 address acquired from the transmitted signal; and providing a service, via the Internet, to the terminal apparatus via the second network (**col. 14, lines 49-67 and col. 16, lines 41-52, where a comparison authenticates the calling session between the calling terminal and the destination terminal**).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporate Reuss' teachings to the teachings of Saito, for the purpose of authenticating communication between terminal apparatus (**col. 13, lines 14-34**).

**As per claim 17**, Reuss-Saito teaches a method wherein, in acquiring before shipment of the terminal apparatus the host address of the terminal apparatus, a host address of an terminal apparatus connected to a first network in an apparatus factory is acquired (**col. 4, lines 47-61 and col. 7, lines 50-54**).

**As per claims 18 and 19**, Reuss-Saito teaches a method wherein, in acquiring the network address of the second network, a part of the network address of the second network is acquired from an Internet service provider for connecting the second network to the Internet and wherein, in acquiring the network address of the second network, a part of the network address of the second network is acquired from a DNS server (**col. 8, lines 1-15 and col. 14, lines 56-64**).

As per **claim 20**, claim 20 is substantially the same as claim 16 and list similar limitations, but in apparatus form rather than method form. Therefore, the rejection for claim 16 applies equally as well to claim 20.

### ***CONCLUSION***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joiya Cloud whose telephone number is 571-270-1146. The examiner can normally be reached Monday to Friday from on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3922.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***JMC***

**January 24, 2010**

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444